

REMARKS

The December 12, 2007 Office Action regarding the above-identified application has been carefully considered; and the claim amendments above together with the remarks that follow are presented in a bona fide effort to respond thereto and address all issues raised in that Action.

By amendment above, Applicants have moved limitations of dependent claim 51 up to independent claim 44 and moved limitations of dependent claim 55 up to independent claim 52. Accordingly, dependent claims 51 and 55 have been cancelled. As such claims 44 and 52 now correspond to previously considered claims 51 and 55 recast in independent form. Since claims 51 and 55 were previously considered, such amendments should not raise any issues requiring further search or consideration by the Examiner. These amendments to claims 44 and 52 were not earlier presented because US Patent no. 6,467,687 to Hill et al. was not previously applied and as a result Applicants did not have an earlier opportunity to consider claim scope vis-à-vis that newly applied patent. Also, system claims 56 and 57 have been cancelled to reduce issues. For reasons discussed below, it is believed that this case is now in condition for allowance. However, if not allowable, it is submitted that the amendments above reduce issues for purposes of Appeal by reducing the number of rejected claims and narrowing the scope of claim coverage in a manner believed to distinguish over newly applied art. For the reasons outlined above, entry of the amendments at this stage of prosecution is appropriate under 37 C.F.R. § 1.136.

Prompt entry and favorable reconsideration of this application, based on the claim set listed above, is respectfully requested.

The final Office Action included a rejection of claims 44-46, 48-53 and 55-57 under 35 U.S.C. § 103 as unpatentable over US Patent no. 6,467,687 to Hill et al. (hereinafter Hill) in

combination with US patent no. 6,650,431 to Roberts et al. (hereinafter Roberts). Claims 47 and 54 then were rejected under 35 U.S.C. § 103 as unpatentable over the combination of Hill and Roberts, further in view of US patent no. 7,034,951 to Jones et al. (hereinafter Jones). These rejections are traversed on the ground that neither the combination of Hill and Roberts nor the combination of Hill, Roberts and Jones satisfies all of the recitations of Applicants' independent claims 44 and 52. Applicants respectfully submit that the pending claims 44-50 and 52-54 are patentable over the applied art and that the latest art rejections should be withdrawn.

Independent claim 44 recites, *inter alia*:

receiving a soft copy of a part of the document which is to be printed;

generating multiple print files from the soft copy;

applying the multiple print files to individual printers to print corresponding document portions from the print files;

...

adding an auxiliary item, not printed from a print file from the soft copy, to the collated hard copy portion of the document to form the final document;

As such, claim 44 expressly requires generating at least two (multiple) print files from the received soft copy, applying those two print files to individual printers and adding an auxiliary item. The claim expressly recites that the auxiliary item is an item not printed from a print file from the soft copy.

Independent claim 52 recites, *inter alia*:

generating multiple print files from a soft copy of a part of the document which is to be printed;

supplying the multiple print files to individual printers to direct the printers to print corresponding document portions from the print files;

controlling at least one device to collate the printed document portions from the printers into a single collated hard copy portion of the document and to

add an auxiliary item, not printed from a print file from the soft copy, to the collated hard copy portion of the document to form the final document;

Hence, claim 52 expressly requires generating at least two (multiple) print files from one soft copy, supplying those two print files to individual printers and controlling at least one device to add an auxiliary item to the collated hard copy portion. The claim expressly recites that the auxiliary item is an item not printed from a print file from the soft copy.

It is respectfully submitted that neither the combination of Hill and Roberts nor the combination of Hill, Roberts and Jones would result in a methodology in which a soft copy is used to generate two or more print files which are used to print two or more documents portions, and an auxiliary item is added to the collated hard copy document portions, where the auxiliary item is an **item not printed from a print file from the soft copy**, as in Applicants' independent claims. It is noted that Applicants' specification disclosed at least one example in which the auxiliary item (e.g. a label) was also generated via the printers (see paragraph 0045). However, the pending claims have been limited to the case where the auxiliary item is not printed from a print file developed from the soft copy.

Hill discloses an embossed card package production system. The disclosed system includes a computer 12, a form printer 48 and a card embosser/encoder section 20. In operation, the system embosses and encodes information on a card based on account information from card data memory 40 (see e.g. column 4, lines 29-34; and column 8, lines 35-46). The system also prints account related information on the associated form using the same account information via the form data memory 44 and the printer 48, which is the same data as from the card data memory 40 (see e.g. column 7, lines 1-19). As such, Hill prints/embosses both the forms and the cards using at least some common account information, during concurrent running of the form printer and the card embosser. Hill does not meet the claim requirement for adding an auxiliary

item to collated hard copy document portions, where the auxiliary item is an **item not printed from a print file generated from the one soft copy** used to print the portions of the hard copy document.

Roberts discloses a technique for selective routing of portions of an electronic document to different output devices. In Roberts, the electronic document comprises first and second sets of pages having different characteristics. Roberts identifies the pages of the different sets and selectively routes the pages to compatible output devices, e.g. different types of printers. Attention may be directed, for example, to the abstract of the Roberts patent. Roberts does not teach addition of an auxiliary item not printed from one of the derived print files. It is respectfully submitted that if one were to combine Roberts with Hill as proposed in the rejection, the resulting methodology would print all of the items (hard copy document portions and the card) essentially in parallel from common account data (Hill) or from one electronic document (Roberts). In the system of Hill, and thus in the combination of Hill and Roberts (or the combination of Hill, Roberts and Jones), the card is just another hard copy item produced by the printers/embosser of the system in response to the data from the control computer. The resulting methodology would not generate two or print files from one soft copy, use those files to print two or more documents portions, **and** add an auxiliary item to the collated hard copy document portions **where the auxiliary item is an item not printed from a print file from the soft copy**, as in Applicants' independent claims.

Since the hard copy documents are printed from files generated from an original soft copy, but the auxiliary item is an item not printed from a print file from that soft copy, verification takes on added significance.

For example, claim 44 further recites, *inter alia*:

scanning one or more sheets of the collated hard copy portion of the document to detect an identifier on the collated hard copy portion of the document;

...

scanning the auxiliary item to detect an identifier on the auxiliary item;
and

...

the step of verifying completion comprises comparing the detected identifiers to desired attributes for the final document specified in a data file for the document to be created.

Hence, claim 44 expressly requires scanning at least one sheet of the collated hard copy portion of the document to detect an identifier on the collated hard copy portion of the document and scanning the auxiliary item to detect an identifier on the auxiliary item. Completion is then verified by comparing the detected identifiers to desired attributes for the final document specified in a data file for the document to be created.

Claim 52 further recites, *inter alia*:

obtaining an identifier on the collated hard copy portion of the document based on a scanning of one or more sheets of the collated hard copy portion of the document;

obtaining an identifier on the auxiliary item based on a scanning the auxiliary item; and

...

the step of verifying completion comprises comparing the detected identifiers to desired attributes for the final document specified in a data file for the document to be created.

Hence, claim 54 expressly requires obtaining identifiers from the collated hard copy portion of the document and from the auxiliary item based on scanning thereof. Completion is then verified by comparing the identifiers obtained by the scanning with desired attributes for the final document specified in a data file for the document to be created.

It is respectfully submitted that neither the combination of Hill and Roberts nor the combination of Hill, Roberts and Jones would result in a methodology in which the identifiers from the collated hard copy portion of the document and from the auxiliary item are compared to desired attributes for the final document specified in a data file for the document, to verify completion of the document (with hard copy and auxiliary item).

From the flow chart of Hill in FIG. 5A, it appears that Hill reads the card and verifies the card data at step 106 (see also column 9, lines 33-50). Hill also verifies the form data (step 112). These are two separate steps that apparently precede merging of the card and the form. In step 114 the computer file, the embossed card information read from the card, the encoded information read from the card, and the printed information read from the carrier form are all compared together to determine if there is a match. If all the data matches, the card and the form are accepted and merged together (at step 120). Attention is directed to column 12, lines 25-33. Apparently, any part (card or form) that does not match is rejected and reprinted with correct material for subsequent merging. Attention is directed to column 12, lines 34-55. It is believed that this matching, rejecting and reprinting approach differs from the document completion verification recited in the independent claims. It is respectfully submitted that Hill does not verify completion by comparing the detected identifiers from the auxiliary item (Hill's card) and the hard copy (Hill's form) to desired attributes for the final document specified in a data file for the document to be created. Hill would apparently reprint any incorrect portion. Roberts does not make up for this deficiency of Hill because Roberts only suggests scanning printed documents before merging and does not teach detecting or obtaining an identifier of an auxiliary item and verifying completion using the auxiliary item identifier. Applicants therefore submit that Hill and Roberts together (or the combination of Hill, Roberts and Jones) would not result in

a method in which the identifiers from the collated hard copy portion of the document and from the auxiliary item are compared to desired attributes for the final document specified in a data file for the document, to verify completion of the document, as required by the pending independent claims.

In view of the distinctions over Hill and Roberts discussed above, the art rejection of claims 44-46, 48-50, 52 and 53 should now be overcome.

The discussion above has focused mainly on the combination of Hill and Roberts, as that combination was applied to reject the independent claims (44 and 52) as well as the dependent claims (51 and 55) from which Applicants have now added limitations up into the independent claims. The Action cited the additional document to Jones only for a teaching of reprinting a portion of the document, with respect to dependent claims 47 and 54. Addition of a reprint step to the combination of Hill and Roberts would not result in a combination that satisfies the above-discussed requirements of independent claims 44 and 52. Since dependent claims 47 and 54 include the requirements of their respective independent claims, claims 47 and 54 also should be allowable at least for the same reasons as the independent claims.

Upon entry of the above claim amendments, claims 44-50 and 52-54 remain active in this application, all of which should be patentable over the art applied in the latest Action. Applicants therefore submit that all of the claims are in condition for allowance. Accordingly, this case should now be ready to pass to issue; and Applicants respectfully request a prompt favorable reconsideration of this matter.

It is believed that this response addresses all issues raised in the December 12, 2007 Office Action. However, if any further issue should arise that may be addressed in an interview

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or by an Examiner's amendment, it is requested that the Examiner telephone Applicants' representative at the number shown below.

To the extent necessary, if any, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, reading "Keith E. George". The signature is fluid and cursive, with the first name "Keith" and last name "George" clearly legible.

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